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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,775

08/25/2006

Kiyomi Sakamoto

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2464

22852

7590

02/02/2010

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EXAMINER

OLADAPO, TAIWO

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,775	<b>Applicant(s)</b> SAKAMOTO ET AL.	
	<b>Examiner</b> TAIWO OLADAPO	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/20/2010 has been entered.

2. The amendment dated 01/20/2010 has been considered and entered for the record. The amendment does not overcome previous rejections which are hereby maintained. New claim is rejected below.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
6. Claims 1 – 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujita et al. (US 2006/0073989) in view of Butke et al. (US 5,843,873)
7. In regards to claims 1 – 4, Fujita teaches a grease composition for automobile electrical equipment comprising base oil and thickener (abstract), carbon black with a mean particle size of preferably 10 – 300nm [0037], extreme pressure (EP) additives such as zinc dithiophosphate and organomolybdenum compounds [0041], and salts of organic acids [0040]. Fujita does not recite that the composition comprises carbonate overbased fatty acid salt complex.

Butke is added to teach lubricant and grease compositions as in the invention of Fujita (column 2 lines 22 – 32). Butke teaches the composition comprises surfactants or dispersants (column 10 lines 10 – 15). In Examples 32 and 59, Butke teaches blends comprising surfactants such as calcium carbonate-overbased tall oil fatty acid carboxylate (P) and calcium carbonate-overbased fatty acid carboxylate (WW) used in the composition (Table 3 & 4).

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It would have been obvious for one of ordinary skill in the art at the time of the invention to have used the surfactants taught by Butke in the grease composition of Fujita, as Butke teaches they are suitable for use in greases.

8. Claims 1 – 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita et al. (US 6,432,889) in view of Iso et al. (US 2002/0076125) and further in view of Butke et al. (US 5,843,873)

9. In regards to claims 1 – 4, Kinoshita teaches a grease composition for a constant velocity (CV) joint comprising a base oil, thickener, extreme pressure agents such as phosphorus and molybdenum compounds (abstract, column 1 lines 4 – 6, and column 7 lines 40 – 47). The grease comprises carbonated metal sulfonates (column 5 lines 34 – 44). Kinoshita does not teach that the grease comprises carbon black.

Iso teaches a grease composition for rolling bearing which is a part in constant motion (abstract). Iso similarly teaches the grease comprises carbon black having a mean particle size of 10 to 300nm [0029]. Kinoshita and Iso combined do not recite that the composition comprises carbonate overbased fatty acid salt complex.

Butke is added to teach lubricant and grease compositions for use in various applications such as to lubricate transaxles which utilize CV joints as in the invention of Fujita (column 2 lines 22 – 32). Butke teaches the composition comprises surfactants or dispersants (column 10 lines 10 – 15). In Examples 32 and 59, Butke teaches blends comprising surfactants such as calcium carbonate-overbased tall oil fatty acid carboxylate (P) and calcium carbonate-overbased fatty acid carboxylate (WW) used in the composition (Table 3 & 4).

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It would have been obvious for one of ordinary skill in the art at the time of the invention to have used the surfactants taught by Butke in the grease composition of Kinoshita, as Butke teaches they are suitable for use in greases for transaxle applications which have CV joints. One of ordinary skill in the art at the time of the invention would have used the solid lubricant taught by Iso in the invention of Kinoshita, because Iso provides solid carbon black lubricants with suitable particle size for use in greases.

### ***Response to Arguments***

10. Applicant's arguments have been considered but are not persuasive
11. Applicants argue that Butke teaches a composition that does not contain thickeners and therefore is not suitable as a grease composition. However, Butke does recite grease compositions (column 2 line 27).
12. Applicants further assert there are unexpected superior results achieved by the claimed lubricant over the inventions of Kinoshita, Fujita and Butke. Applicant's point to [0010] and [0011] of the applicant's specification which merely alleges the composition can achieve a high level balance between anti-flaking, anti-seizure and antiwear. No evidence is provided by the applicants that compares the flaking, seizure and wear properties of the lubricant with Kinoshita, Fujita and Butke. Moreover, the inventive examples used to obtain the alleged unexpected results are not commensurate in scope with the claims. The inventive examples in Tables 1 to 3 include additives such as polysulfide, sulfurized oil, phosphates, sulfonate, graphite and antioxidant which are not present in the claims. The inventive examples teach specific amounts

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of specific additives while the claims allow for any “effective amount” of additive. Applicants therefore have not demonstrated superior results sufficient to rebut the case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Ellen M McAvoy/  
Primary Examiner, Art Unit 1797